

REMARKS

Applicants courteously solicit favorable reconsideration and allowance with respect to all claims.

Applicants have amended claim 1, canceled claims 3, 4, 7, and 8, and added new claim 11. New claim 11 corresponds to former claim 4 and properly depends from claims 1, 2, 9 and 10. Since new claim 11 replaces claim 4 and carries forward the claim 4 subject matter that was previously before the Examiner, there is no new matter and there is no new issue. Claims 3 was multiple dependent claim dependent from 1 or 2), no further multiple dependent claim fee is due for new claim 11. Since multiple dependent claim 3 and claims 4, 7 and 8 are canceled, the total number of claims presented for consideration has not increased. The issues for consideration are reduced since claims 7 and 8 have been canceled without prejudice, whereby the rejections under 35 U.S.C. 101 and 112(2) are moot.

Applicants therefore courteously submit this Amendment should be entered - at least for purposes of an Appeal.

Applicants submit that claims 1-4 and 9-10 define novel and unobvious inventions over the combination of U.S. Patent No. 4,840,797 (Boursier) in view of U.S. Patent No. 4,849,023 (Devos).

Applicants submit that claims 1-4 and 9-10 would not have been obvious to one of ordinary skill in the art in view of Boursier, even if it were combined with Devos.

The Boursier reference does not describe, nor would it have taught the dry matter content of the syrup being of from 68-72% as in claim 1.

The Boursier reference does not describe, nor would it be taught the dry matter content of the syrup being of from 70-72% as in claim 9.

The Boursier reference may mention a relatively range, but that neither describes Applicant's range, nor suggests them. As the Federal Circuit explained in the analogous situation in *Atofina*, "A temperature range of over 100 degrees is not a small genus and the range of temperatures of JP 51-82206 does not disclose Atofina's

temperature range," and [m]oreover, the disclosure of a range of 150 to 350 °C does not constitute a specific disclosure of the endpoints of that range, i.e., 150 °C and 350 °C, as Great Lakes asserts. The disclosure is only that of a range, not a specific temperature in that range, and the disclosure of a range is no more a disclosure of the end points of the range than it is of each of the intermediate points. Thus, JP 51-82206 does not disclose a specific embodiment of the claimed temperature range." *Atofina v. Great Lakes Chemical*, 78 U.S.P.Q.2d 1417,1423, (Fed. Cir. 2006).

The Boursier references teaches directly away from the claimed inventions, including those in claims 1, 2, 9, 10 and 11. The Boursier reference specifically admits that "[b]eyond 65% the crystallization is irregular and surface defects appear; below 50%, the chewing-gums are sticky and the dry times considerable." Boursier, column 6, lines 19-21. The Boursier reference therefore would not have suggested the dry contents in claims 1, 2 or 9, nor would it have suggested "comestibles have a smooth, regular surface" when the dry content is above 65%. The Boursier reference would have taught away from the chewing gum according to claim 1 or, for instance, claim 11 (former claim 4).

The Boursier reference would not have taught the person of ordinary skill in the art that a dry matter content of syrup comprises from 0.7-1.5 wt% of DE₄₊.

In fact, the Boursier would have taught a range of at most from 55-65 wt% (column 2, line 40) and that would not have suggested the more narrow yet higher range of 68-72%.

The secondary Devos reference would not have suggested changing the approach dictated according to the Boursier reference.

The present specification includes the evidentiary basis from which to reach the foregoing conclusions. The evidentiary basis would effectively rebut any prima facie case even if such a case were established, which case has not been established.

The Boursier reference is the U.S. counterpart to EPO patent publication EP 0 201 412. That stands unrebutted in the present record.

Applicants' specification discloses to those skilled in the art that Boursier's EP 0 201 412 describes:

a confectionary or pharmaceutical product provided with a hard, sugarless coating obtained by hard coating using a maltol syrup having a dry matter content of from 50-75% by weight, the coating being essentially crystalline and comprising at least 90% by weight of maltol (specification, page 1, paragraph 4).

Applicants' specification further discloses for those skilled in the art that according to Boursier:

EP 0 201 412 describes a maltol syrup which is consisting of 97.1% by weight of maltol, 1.1% by weight of sorbitol and 1.8% by weight of maltotriitol. Said syrup is devoid of any DP₄₊ fraction, and it is clearly demonstrated that it is not possible to obtain a regular surface when applying the maltol syrup at a dry substance content higher than 65%. In cases where higher drier substance is used, the crystallization is irregular and defects on the surface appear (specification, page 3, penultimate paragraph).

emphasis added); see also Boursier at column 8, lines 19-21. Indeed, Applicants' specification, which was verified with the oath and declaration, includes the evidentiary summation:

Surprisingly, the current invention demonstrates that maltitol syrups containing from 0.7-1.5% DP₄₊ on dry matter content, and from 95-97% maltitol on dry matter content, are suitable to use syrups at a dry substance higher than 65%, i.e. at dry substance of 68-72% and yet regular hard coatings are obtained (see FIG. 1). Preferably, maltitol syrups having a dry matter content from 70-72%, result in a hard coating with a homogeneous surface.

Specification, as filed, page 3 bridging to page 4 (emphasis added).¹

¹ "It should not be necessary for this court to point out that a patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the "subject matter as a whole" which should always be considered in determining the obviousness of an invention under 35 U.S.C. 103. In re Antonson, 47 CCPA 740, 272 F.2d 948, 124 USPQ 132 ; In re Linnert, 50 CCPA 753, 309 F.2d

Applicants' comestibles with a hard coating exhibiting a homogeneous surface is the antithesis of what Boursier teaches, and Applicants' discovery of the problem and their inventive solution for overcoming it would not have been suggested by Boursier alone, nor even if combined with Devos, inasmuch as the latter shows no awareness of the problem or a way of solving it.

Indeed, the present specification additionally teaches Applicants' invention concerns "[e]specially a sugar-free hard-coated comestible wherein the core is regularly formed and remains intact during processing and during any post-treatment (such as packaging)." Specification, as filed, page 5, paragraph starting at line 5.

The evidentiary showing in the specification consistent with the above-stated results is amply illustrated in FIG. 1. FIG. 1 is a photograph with magnification of 6 x 10. The photograph shows that the hard coating prepared with the liquid maltol syrup of 96% maltol and 0.7-1.5% by weight of DP₄₊ based on dry matter yields a smooth regular surface.

None-the-less, despite the Boursier teaching of surface defects and irregularities, at dry contents greater than 65%, the Office Action asserts a different composition according to Devos with alleged dry contents greater than 65% would have been substituted into Boursier. Devos is inconsistent with Boursier, and there would have been no expectation of success as to Applicant's claimed inventions.

Therefore, even if, for the sake of argument only, one were to have engaged in hindsight modification of the Boursier reference according to the Office Action, the expected result would, at best, be an irregular crystallization and defects on the surface of the sugar-coated comestible that would be a disadvantageous and undesired and unacceptable result. Why? Boursier made it clear "[b]eyond 65%, the

498, 135 USPQ 307 . The court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is, we must view the prior art without reading into that art appellant's teachings. In *re Murray*, 46 CCPA 905, 268 F.2d 226, 122 USPQ 364 ; In *re Sporck*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360." In *re Spinnoble*, 160 U.S.P.Q. 237, 243 (CCPA 1969).

crystallization is irregular and surface defects appear..." Column 6, lines 19-21.²

Applicants have achieved success, whereas the approach postulated according to the Office Action results in failure for the reasons set forth in the Boursier reference.

Thus, the references would not have been combined, and even if they were, there would have been no reason to substitute Devos's different composition for the composition in Boursier, nor would there have been a reasonable expectation of success.

Applicants, therefore, earnestly but courteously submit the obviousness rejection should be reconsidered and withdrawn.

If the rejection is notwithdrawn, then Applicants courteously submit the Examiner should provide an Examiner's affidavit. This necessarily follows because the rejection founders on its own shoals: the two references are divergent, and one teaches away from the very thesis advocated in the Office Action.

Applicants courteously but earnestly solicit that claims 5 and 6 also define unobvious inventions over the Corriveau reference taken in view of the Devos reference. Applicants submit that there would have been no reasonable expectation of success even if a person of ordinary skill in the art had undertaken the statutorily proscribed hindsight - retrospective analysis - detailed in the Office Action. Even if the hindsight guided retrospective analysis were appropriate, which it is not (as seen from the statutory command in 35 U.S.C. §103(a)), the specification herein details the evidentiary basis that refutes the result postulated in the Office Action, i.e., shows at the very least that the approach would not have been expected to be successful.

² "Notwithstanding our analysis above, concerning appellant's recognition of the source of the problem and solution thereof, we believe that the multi-reference rejection *affirmed* below is improper for reasons existing within the disclosures of the references themselves, namely, that the references themselves teach away from the combination." *In re Spinnoble*, 160 USPQ at 244 (emphasis added).

Accordingly, reconsideration and withdrawal of this rejection is courteously but earnestly solicited.

The Commissioner is hereby authorized to charge any required fee not otherwise paid, including application processing, extension, and extra claims fees, in this application to Deposit Account 06-1135 regarding our order number 7393/84118.

Respectfully submitted,

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